

VZCZCXYZ0000
RR RUEHWEB

DE RUEHGV #1118/01 3421217
ZNR UUUUU ZZH
R 081217Z DEC 09
FM USMISSION GENEVA
TO RUEHC/SECSTATE WASHDC 0523
INFO RUCPDO/DEPT OF COMMERCE WASHINGTON DC

UNCLAS GENEVA 001118

SIPDIS

SECSTATE FOR EEB; COMMERCE FOR USPTO

E.O. 12958: N/A

TAGS: [ECON](#) [KIPR](#) [WIPO](#)

SUBJECT: WIPO Standing Committee on the Law of Trademarks,
Industrial Designs, and Geographical Indications (SCT), November
23-26, 2009

¶1. SUMMARY: The 22nd session of the WIPO Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications (SCT) continued constructive discussions on topics remaining from the 21st session. Work on most of these issues is coming to a conclusion and thus the SCT members may need to plan for future work. This session generally served as an opportunity for Members to clarify points and submissions in their working documents as well as an opportunity for Members to ask for clarification from other Members on their policy rationale for such positions. The USDEL sought specific information from the Committee members on how national offices are handling applications for marks which refer to President Barack Obama or consist of the President's name. In general, discussions at this session were productive and non-controversial, and with the strong leadership of the Chair, the meeting was conducted at an efficient pace. END SUMMARY

¶2. The Twenty-Second session of the World Intellectual Property Organization's Standing Committee on the Law of Trademark, Industrial Designs, and Geographical Indications (SCT) was held from November 23 - 26, 2009, in Geneva. Mr Adil El Maliki (Kingdom of Morocco) was elected as Chair of the Twenty Second Session of the SCT at the prior session. The United States was represented by John Rodriguez and Janis Long, United States Patent and Trademark Office (USPTO).

Industrial Designs

¶3. Several sessions ago, Norway proposed that the SCT begin work on industrial design formality issues with the potential goal of a Diplomatic Conference for a design law treaty (DLT), similar to the Patent Law Treaty (PLT) or the Trademark Law Treaty (TLT). The SCT discussed document SCT/22/6 which identified possible "areas of convergence" which could evolve into an eventual basic text for a design formalities treaty. The document reflected earlier input on design formalities which the SCT members had provided at the previous session.

¶4. The United States protects industrial designs, as identified in the WTO Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), via the U.S. design patent system. Many other countries around the world protect designs through a sui generis design registration system with little to no examination as to novelty - at least until a claim of infringement is made - and with minimal time to registration, as well as a relatively short term of protection, with possible renewals.

¶5. Discussion of the document was constructive as SCT members were given the opportunity to state their agreement or objections as to whether the identified areas of convergence were actual "areas of convergence." Many Members indicated that some of "areas of convergence" did not take into account their national practices. Based upon the comments and proposals made at this session, the Chair requested the Secretariat to revise the current "areas of convergent" document and outline those areas where there does continue to be "areas of convergence," then indicate where there are general tendencies in the law and practice of SCT members and

finally identify those areas where no concrete convergence could be established at this time. A revised paper will be considered at the next session of the SCT.

¶16. In regards to whether the working paper evolves into a text for a design formalities text, from the perspective of the United States, it is potentially premature to work on design formalities when the United States and many others have yet to implement the Geneva Act of the Hague Agreement for the Registration of Industrial Designs. Implementing the Hague Agreement will necessitate various changes to U.S. law and practice that will likely harmonize international practice in some areas. However, until the U.S. has further consultations with U.S. industry and Congress, there is little incentive or flexibility for the USDEL to fully engage in any in-depth harmonization discussions on this issue.

Digital Access Service for Priority Documents

¶17. The Digital Access Service (DAS) for Priority Documents is currently available for submitting priority documents related to patent filings, and the SCT considered whether to extend the service to priority documents relating to industrial designs and trademarks.

Discussion focused on working document SCT/22/7 which provided information on how the DAS currently works for submitting priority documents in patent filings while outlining how the service could be extended to industrial designs and trademarks. At this session, the International Bureau (IB) provided a live demonstration of the DAS to illustrate the step by step process that an applicant currently encounters when submitting priority documents to national offices which have joined the system. (NOTE: The USPTO joined the system in July 2009. Other offices include the Japan Patent Office, the PCT Office of the International Bureau, the UK Patent Office and the Spanish Patent Office.)

¶18. Most Members believe that the DAS will be a useful tool in facilitating the transmission of priority documents and will enhance efficiency within their national IP offices. Translation of documents appeared to be an important element of the DAS that many Members identified as being particularly beneficial. A few Members had questions as to the cost of implementing the system within their own National Offices as well as whether such a system would be compatible with their existing national practices. The IB indicated that the DAS was only meant to provide simplicity to the current framework and would be an option for applicants to take advantage of if they were interested. The Chair indicated that all comments would be taken into account and requested the Secretariat to advance work on the establishment of a Digital Access Service for Priority Documents for industrial designs and for trademarks in a way that would ensure the largest possible participation of interested offices in such a service.

Trademark Grounds of Refusal

¶19. The SCT discussed document SCT/22/2 which consisted of submissions about national office practices. The committee focused on specific cases and examples of refusals submitted by the Members.

Many Members expressed appreciation for the document and indicated that it is a helpful tool to improve their own office practice and looked forward to an enhanced paper with additional examples that could be used for training and education. As Members expressed interest in supplementing the paper with additional information and examples, the Chair requested that input be provided by the end of January 2010, with a revised paper to be considered at the next Session and ultimately adopted by the Committee and published on the SCT website soon thereafter.

¶10. The USDEL inquired how national offices handle applications containing the term: OBAMA. Many countries indicated they have existing legislation which would permit refusal of an application during ex parte examination for a mark that consisted of a person's name (famous or non-famous) when there is no authorization or consent from the identified individual. Other members indicated that an application could only be rejected via an opposition or cancellation commenced by the identified individual or his/her agent/representative. These Members conceded that such practice was

not always efficient and they are reviewing how to amend their trademark laws to allow for refusals during ex parte examination. (NOTE: USPTO will continue to advance and raise awareness of this issue through bilateral meetings with foreign trademark officials as well as provide additional training on the issue to foreign trademark examiners at USPTO programs).

Certification and Collective Marks

¶11. The SCT considered document SCT/22/3. As an earlier and almost identical draft was discussed in detail at the previous session and with Members attempting to avoid a repeat discussion, discussion was very limited. A few members made comments indicating their national systems did not provide for certain formalities as indicated in the paper. Some members indicated they had yet to provide information regarding their national practice on the procedural and technical aspects of certification and collective marks and wanted to do so. The Chair indicated that Members will have an opportunity to make additional comments until the end of January 2010, at which time the Secretariat will revise the current paper and present a revised paper for consideration by the Committee at the next session.

Questionnaire concerning Official Names of States

¶12. Discussion focused on document SCT/22/4 which is a draft questionnaire concerning the protection of official names of States against registration or use as trademarks. At the previous session of the Committee, Jamaica had introduced a proposal to reopen the Paris Convention to extend Article 6ter's protection for symbols of state sovereignty to include country names, including in translation, in abbreviated or adjectival form, as well as in any homonymous forms. As there was no support for such proposal within the SCT but recognizing sensitivities for Jamaica to achieve progress at the SCT as well as to avoid this issue in other forums, the Committee agreed to have the IB prepare a questionnaire soliciting input from delegations as to how trademark applications containing or consisting of country names would be handled at the national level.

¶13. Numerous delegations provided comments to the draft questionnaire, making suggestions to modify existing questions or to add new questions. A few delegations raised questions concerning what constitutes an official name of a State. Jamaica introduced edits to request information on how non-commercial uses of official names of States is being handled within national trademark systems. As there were many proposals for edits, the Chair requested the Secretariat to revise the existing draft questionnaire, taking into

account the comments of the Committee made at this session. The revised questionnaire will be posted on the SCT website intersessionally where members can provide additional comment. The SCT will review the subsequent questionnaire at the next session with that expectation that it be adopted and circulated.

¶14. The Twenty-Third Session of the SCT is scheduled for the week of April 19 - 23, 2010, in Geneva.

GRIFFITHS#